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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,716	12/22/2000	Gary W. Grube	276440-11	1179
50905	7590	07/15/2005	EXAMINER	
N. KENNETH BURRASTON KIRTON & MCCONKIE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120			ABRAMS, NEIL	
			ART UNIT	PAPER NUMBER
			2839	

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No. 09/746,716	Applicant(s) GRUBE ET AL.	
	Examiner Neil Abrams	Art Unit 2839	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 14, 16-22, 30-33, 35-51, 61-63, 81-84 is/are pending in the application.
- 4a) Of the above claim(s) 9, 11, 16-21, 43, 49, 69, 68 is/are withdrawn from consideration.

- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) All non-withdrawn is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 33 is objected to lines 12, 13 said substrate^{//} and said beam^{//} have no antecedent basis.

Claims 1, and 33 are noted to be inconsistent with arguments^{discuss} which ~~discusses~~ a single contact element joined to a plurality of column elements". The claims as presented read on a single contact element joined to each column element.

To provide consistency with arguments claims 1, line 10 and claim 33, line 11 could be amended to recite a contact element, said contact element joined to a second end of each...^{//}

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, 10, 13, 14, 22-51, 61-63, 65-67, 69-84 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,811,406. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this case define broadened variations of parent claims and recite similar structure but with use of different terms.

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Applicant has agreed to file a terminal disclaimer, ~~to~~ expedite the case, the terminal disclaimer should be supplied with next response.

If applicant intends that claims be rejoined at allowance dependency should be changed in next response (claim 16) where incorrect.

Claims 1, 2-8, 10, 13, 14, 30, 31, 32, 70-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beaman 551.

For claims 1, Beaman discloses column elements with wire cores 15 (Fig. 7) enclosed by overcoats of hard material (nickel), a contact element 61 at one end of the columns.

Beaman does not disclose the columns to be rigid. Use of rigid contacts is shown at 71. It would have been obvious to form those of fig. 7 to similarly be ~~be~~ substantially rigid. This will enable higher pressures to be exerted at mating. Obvious to accomplish this by use of hard plating as discussed in col. 7, lines 10-13.

Dependent claims are not at issue and are treated with parent claims.

As an alternative, fig. 10 is applied with rigid contacts 71 joined to substrate 12 and having ^{//}hard ^{//}coatings. Fig. 10 is not disclosed as having a core formed of a wire or as having a contact element at one end. Beaman discloses use of wire cores 15 and of end contact parts 61 and 19 (fig. 9).

Obvious to use these types in fig. 10, the wires enabling easier manufacture and the end contacts enabling scraping or piercing for better contacting.

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For all claims, ^{note}~~note~~ as discussed above that applicant is urging patentability based on a single contact (beam) joined to a plurality of column elements and that claim 1 does not clearly require this feature.

In view of this uncertainty as to issues dependent claims are included in the claim 1 rejection. Claim 1, amended as discussed above, to require the ^{//}to a plurality of columns ^{//}feature would be allowable apart from double patenting.

Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by Beaman 551.

Note column element 15, 17 with wire 15 and with contact element 61 at its top. To avoid Beaman applicant refers to a parent case ^{and publication}fig. 7F, however, in the cited publication, page 11, discussion of fig. 7F, column element 730 is not disclosed to ^{therefor}include a wire claim 22 does not obtain priority benefit based on fig. 7F. Basis for priority benefit must be specifically pointed out.

Claim 22 is rejected under 35 U.S.C. 102(b) as anticipated by ~~ex. in the~~
~~alternative, under 35 U.S.C. 102(b) as obvious over~~ Beaman 885).

Beaman fig. 1 contact structure includes columns (40) attached to substrate 20 at one end and having contact elements 50 joined at their upper ends, the columns comprising wires.

Applicant's arguments filed with the amendment and pertinent to claims now rejected have been fully considered but they are not persuasive. ~~///~~

Arguments are responded to above. For claim 22 note new reference cited. Also note that no arguments are presented as to specific teachings of Beaman 551.

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Claims 35-40, 41, 42, 45-51, 68, 69, 61-63, 66, 67 and 81-84 are allowable apart from double patenting rejection. Claim 33 ~~also~~ includes allowable material. *but note objections on page 2, lines 1-8.*

Any inquiry concerning this communication should be directed to Neil Abrams at telephone number (571)272-2089.

Abrams/ds

07/12/05


NEIL ABRAMS
EXAMINER
ART UNIT 322